

REMARKS

§101 rejections

In the 1 December 2006 Office Action, claims 28 - 70 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. More specifically the Examiner states that the “claims involves disjointed concepts and ideas based in the abstract, all of which fails to provide a practical application and is insufficient to establish a real world "tangible" result.” This rejection is respectfully traversed by in two ways. First, by noting that the claim rejections fail under both standards of the Administrative Procedures Act and are therefore moot. Second, by noting that the Examiner has failed to establish a prima facie case that any of the claims are directed to non-statutory subject matter.

As stated previously, the first way the Assignee will respectfully traverse the rejection of claims 28 – 70 will be by noting that every one of the rejections are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of USPTO findings of fact are the standards set forth in the Administrative Procedure Act ("APA") at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. The Supreme Court has defined substantial evidence as “substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence. Consolidated, 305 U.S. at 229-30 (citations omitted)”. The Assignee respectfully submits that the instant Office Action fails to provide even a scintilla of evidence to support the allegation of non utility it contains and that as a result it fails to meet the substantial evidence standard. The Assignee respectfully submits that the 1 December 2006 Office Action also fails to pass the arbitrary and capricious test. In the *Gartside* decision (In re Gartside 203F.3d 1305, 53 U.S.PQ2d 1769 (Fed Circuit 2000)) the First Federal Circuit discussed the arbitrary and capricious standard when it noted:

Because this standard is generally considered to be the most deferential of the APA standards of review, (see *Stein et al.*, *Administrative Law* 51.03, at 51-117 (1999)) the reviewing court analyzes only whether a rational connection exists

between the agency's fact findings and its ultimate action, (see Hyundai Elecs. Indus. Co. v. ITC, 899 F.2d 1204, 1209, 14 USPQ2d 1396, 1400 (Fed. Cir. 1990).

The Assignee respectfully submits that the 1 December 2006 Office Action also fails to pass the arbitrary and capricious test because the Examiner has not completed any discernible fact finding that can be connected to the rejections contained in the Office Action.

The second way the claim rejections will be traversed will be by noting that the Examiner has failed to establish a prima facie case that any of the claims are directed to non-statutory subject matter. As noted in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, the burden is on the USPTO to set forth a prima facie case of unpatentability. The Examiner has simply failed to set forth such a case (or any case for that matter). To the contrary, the Examiner has ignored important aspects of the claimed invention that make it clear that the claims are statutory subject matter. In particular, the Examiner appears to have ignored the fact that each of the independent claims describe a process for transforming aggregated data into a complete context model for an entity. As noted in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility "the Supreme Court noted that one example of a statutory "process" is where the process steps provide a transformation or reduction of an article to a different state or thing (Diehr, 450 U.S. at 183, 209 USPQ at 6). The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility also require that when evaluating whether a claim meets the requirements of section 101, the claim must be considered as a whole. The Assignee respectfully submits that the rejected claims taken as a whole describe the use of a complete entity context to facilitate and optimize the development, discovery and/or delivery of useful data, goods, information, knowledge and/or services. The Examiner has not presented any evidence that any of the claimed functions have no practical utility, are not concrete, are not tangible and/or are not useful. In short, the Examiner has failed to establish a prima facie case that could be used to sustain the §101 rejection of any of the rejected claims 28 – 70. The removal of the §101 claim rejection for every claim is respectfully requested.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reason the prior set of claims were amended was to put the application in a form for issue and allowance by fixing inadvertent clerical errors.

Request for affidavits under 37 C.F.R. 1.104

The 1 December 2006 Office Action appears to be based entirely on opinion(s) that are based on facts in the personal knowledge of one or more employees of the Office. 37 C.F.R. 1.104 provides that:

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

Accordingly, the Assignee requests that an affidavit detailing the facts within the personal knowledge of any employee(s) of the Office that were used to support the statement that the claims involve disjointed concepts and ideas based in the abstract, all of which fails to provide a practical application and is insufficient to establish a real world "tangible" result. The Assignee further requests that affidavits detailing the facts within the personal knowledge of any employee(s) of the Office that support:

- a) an implicit opinion that a complete context has no practical utility, is not concrete, is not tangible and/or is not useful,
- b) an implicit opinion that transforming data into a model of complete context is not statutory subject matter, and
- c) an implicit opinion that using a complete context to facilitate and optimize any aspect of the development, discovery and/or delivery of useful data, goods, information, knowledge and/or services has no practical utility, is not concrete, is not tangible and/or is not useful

be provided on or before the date of the next Office Action. These affidavits are required for inclusion in the appeal that will be filed if the pending claims are not granted.

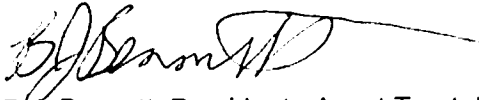
Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'B.J. Bennett', with a long horizontal flourish extending to the right.

B.J. Bennett, President Asset Trust, Inc.

Date: December 9, 2006